

## **DETAILED ACTION**

### ***Response to Amendment/Arguments***

The applicant's amendments and arguments have necessitated the need for a restriction requirement.

The Examiner has considered the applicant's argument with respect to claim 1 that Hoschka does not provide support for dividing programming content into smaller chunks and agrees that Hoschka does not teach this concept. In Hoschka, the chunks are already in existence and there is no evidence that they were divided from programming content. Further search and serious consideration as whether page 7, lines 1-12 and page 9, lines 8-16 of the applicant's specification are enough to meet the enablement requirement for dividing programming content are needed to determine the patentability of claim 1. At this point it is unclear what knowledge the public is receiving in return for exclusionary rights for "dividing programming content".

With respect to claims 11, 29, and 33, the applicant has amended these claims to specify that a manifest file is received with each chunk file, according to the applicant's Figure 2B. This amendment has made further search and consideration of these claims necessary in order to determine patentability.

Both groups do feature the argument that the references do not say anything about splitting up the files so that some are sent electronically and some are sent on a physical medium. This argument is not persuasive for at least the reasons that the claims do not limit the physical medium any way to a portable CD or disk as implied by the applicant. The claimed physical medium is broad enough to cover a transmission or reception buffer or any type of memory used in a network adapter. The applicant's specification provides examples of but does not limit the

Art Unit: 2442

claimed medium. The last limitation does not even state that the files that are transmitted electronically and on the medium are even different files. Therefore the claim covers any transmission of files over a network.

Because the two claimed sets require completely different reasons for determining patentability, a restriction requirement is now warranted.

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 7, 8, 21, 25, 26, and 34-36, drawn to a method for delivering programming content comprising dividing content into chunks of data, creating chunk files, generating a manifest file, and transmitting the manifest file and chunk files to a remote location, classified in class 709, subclass 236.
- II. Claims 11, 12, 17, 18, 23, 27-33, 37, and 38, drawn to a method and apparatus for receiving programming content comprising receiving plural chunk files and a manifest file with each chunk and reassembling and executing or playing the programming content from the chunks of data according to the manifest file, classified in class 709, subclass 230.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination I has separate utility such as the ability to divide programming

Art Unit: 2442

content whereas subcombination II has separate utility such as receiving a manifest file with each individual chunk of data. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;

(e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

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Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOUGLAS B. BLAIR whose telephone number is (571)272-3893. The examiner can normally be reached on 9:00am-5:30pm.

Art Unit: 2442

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip Lee can be reached at (571)272-3967. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Douglas B Blair/  
Primary Examiner, Art Unit 2442